

DEC 15 2010

12/15/2010 18:17

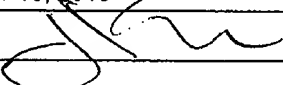

#173 P.004/009

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-09)

Approved for use through 07/31/2012. OMB 0651-0031  
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>December 15, 2010</u></p> <p>Signature <u></u></p> <p>Typed or printed name <u>Jonathan W. Bingham</u></p>		101.0084-01000	
		Application Number	
		09/921,844	
		Filed	
		August 3, 2001	
First Named Inventor			
Gary K. Michelson			
Art Unit		Examiner	
3738		Bruce Edward Snow	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>37,129</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p> Signature <u>Amedeo F. Ferraro</u> Typed or printed name <u>310-286-9800</u> Telephone number <u>December 15, 2010</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED  
CENTRAL FAX CENTER  
DEC 15 2010

PATENT  
Attorney Docket No. 101.0084-01000  
Customer No. 22882

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	) Confirmation No.: 8295
Gary K. Michelson	)
Serial No.: 09/921,844	) Group Art Unit: 3738
Filed: August 3, 2001	) Examiner: Bruce Edward Snow
For: SPINAL IMPLANT SURFACE	)
CONFIGURATION	)

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Further to the Office Action of November 30, 2010 ("Office Action"), Appellant submits the following remarks for consideration by the Members of the Pre-Appeal Conference:

**I. Brief Background**

This application includes two independent claims, claims 1 and 219, both generally drawn to a spinal implant with an implant surface configuration to help retain the implant in the spine (see, e.g., Figs. 12-15). In response to a final Office Action mailed April 5, 2010 (the "April Office Action"), Appellant submitted a RCE with Reply dated October 5, 2010 (the "Reply") adding new claims 287-291, and traversing the Examiner's rejections of all claims under 35 U.S.C. § 103(a) in view of two different combinations: Abei in view of Fraser, and Fraser in view of Paul. Appellant submitted a Supplemental Response on October 26, 2010 together with a Declaration under 37 C.F.R. § 1.131 (the "October Declaration") antedating Fraser. The Examiner mailed an Office Action on November 30, 2010 (the "Office Action") with new rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph of independent claims 1 and 219, and new obvious double-

Pre-Appeal Brief 12-15-10

Application No. 09/921,844  
Pre-Appeal Brief dated December 15, 2010  
Reply to Office Action of November 30, 2010

type patenting rejections, while maintaining the rejections under 35 U.S.C. § 103(a).<sup>1</sup>

## II. Clear Errors or Omissions

(1) The listing of pending claims on the PTOL-326 and claims listed in the Office Action are erroneous because claims 285-291 are pending. (See Reply, Page 13.)

(2) The Examiner's rejection of independent claim 1 under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph is erroneous because the phrase "said base of said perimeter of each of said side facets being longer than said base of said perimeter of said forward facet" would be clear to "a hypothetical person possessing the ordinary level of skill in the pertinent art."<sup>2</sup> In fact, in response to Appellant's amendment dated December 29, 2009 inserting this language into claim 1, the Examiner stated that "Applicant's amendment of claim 1 overcame the rejection" over SU 1107854 (April Office Action, pg. 2, ¶ 2), clearly demonstrating that the Examiner understood this phrase.

(3) The Examiner's rejection of independent claims 1 and 219 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph is erroneous because:

(a) the Examiner's alternative interpretation of the phrase "each of said forward facets" as "describing each of the more than one forward facet on each projection" (Office Action, pg. 5, ¶ 3) is not recited in either independent claim, and thus it is clear that the phrase "each of said forward facets"<sup>3</sup> describes each of the forward facets on every projection; and

(b) applying the standard recited in the MPEP, a hypothetical person possessing the ordinary level of skill in the pertinent art would understand the length of each facet to be measured along the surface of the facet, not parallel to the surface of the implant.<sup>4</sup> (See Office Action, pg. 5, ¶ 4.)

<sup>1</sup> Appellant notes that the Notice of Appeal concurrently filed herewith is in response to a non-final Office Action. According to MPEP § 1204(I), "[a] notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected."

<sup>2</sup> MPEP § 2171, page 2100-216, col. 2, ¶ 3 (Rev. 6, Sept. 2007).

<sup>3</sup> This feature was added in claim 1 in the Amendment dated December 29, 2009, and unobjected to in the April Office Action.

<sup>4</sup> This feature has been present in claim 1 for more than 9 years ago, and in claim 219 for more than 7 years. Independent claim 1, in fact, stood allowed between January 7, 2004 to December 15, 2008, demonstrating that the Examiner understood this feature.

Application No. 09/921,844  
Pre-Appeal Brief dated December 15, 2010  
Reply to Office Action of November 30, 2010

(4) The Examiner's rejection of the claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 7,115,143 (the "'143 patent") is erroneous because the Examiner in the present application held that the species of Figs. 12 and 16 were patentably distinct. (See Restriction Requirement dated October 28, 2002, page 2, lines 7-8 (the "October Restriction Requirement").) The Examiner in the '143 patent also held that the species of Figs. 12 and 16 (showing the same surface configurations as Figs. 12 and 16 of the present application) were patentably distinct. (See '143 Patent, Restriction Requirement dated August 27, 2002, page 2, line 2 (the "August Restriction Requirement").) Appellant elected the species of Fig. 12 in the present application (see Election dated January 28, 2003) and elected the species of Fig. 16 in the '143 patent (see Election dated September 20, 2002). Accordingly, Appellant submits that the claims of the present application are patentably distinct from those of the '143 patent at least for the reasons set forth by the Examiner in the October Restriction Requirement, and by the Examiner of the '143 patent in the August Restriction Requirement in the '143 patent.

(5) The Examiner's rejection of the claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 7,244,727 to Fox et al., entitled "Fused Bicyclic Nitrogen-containing heterocycles," is clearly erroneous because the patents are by different inventive entities and drawn to entirely different subject matter. (See Office Action, page 7, ¶ 1.)

(6) The Examiner's rejections of the claims (up to claim 284) under 35 U.S.C. § 103(a) over Abei in view of Fraser, and Fraser in view of Paul are erroneous because Appellant's traversals and remarks from the Reply stand unchallenged. (See Reply, ¶¶ bridging pages 14-15; and Office Action, pages 2-4.)

(7) The Examiner failed to object to claims 285-291 as being dependent upon a rejected base claim, but otherwise being allowable if rewritten into independent form taking into account any rejection under 35 U.S.C. § 112 of the independent claims. Appellant notes that these claims were not identified as being rejected under art. Even

Application No. 09/921,844  
Pre-Appeal Brief dated December 15, 2010  
Reply to Office Action of November 30, 2010

if the Examiner's use of the phrase "(all claims)" after the listing of claims on pages 7 and 10 of the Office Action is somehow construed to include non-listed claims 285-291, then the Examiner failed to provide any articulation of how the combination of cited references renders the subject matter of claims 285-291 obvious, thus failing to establish a *prima facie* case of obviousness at least for these claims.

(8) The Examiner's conclusion that the October Declaration is insufficient to establish reduction to practice prior to the effective date of Fraser is erroneous for at least the reasons set forth below.

(a) The Examiner's basis for evaluating the evidence is incorrect because it relies on proving "conception." (See Office Action, pg. 2, ¶ 3, lines 1-8; and page 4, ¶ 3, lines 1-4.) Appellant's evidence relates to reduction to practice prior to the earliest effective date of Fraser (see October Declaration, ¶ 3), not conception.

(b) The Examiner's contentions that "applicant only indicates that exhibit D supports claim 1" or "claim 219" are *prima facie* in error. (Office Action, pg. 3, ¶ 2; and pg. 4, ¶ 2.) Pages 2-4 of the October Declaration set forth the details of claims 1 and 219 relative to all of the Exhibits, specifically referencing one or more Exhibits that best show a particular feature. (October Declaration, ¶ 5.)

(c) The Examiner misconstrues the purpose of Exhibit D. The Examiner repeatedly asserts that only Exhibit D supports portions of claims 1 and 219. (Office Action, pg. 3, ¶ 2, pg. 4, ¶¶ 2-4.) Exhibit D was used to illustrate the portions of claims 1 and 219 that are not easily visible in the photos of the actual implant. According to the sworn Declaration by Appellant, "Figs. 12-15 [of Exhibit D] show an expanded view of the type of surface configuration machined on the surface of the implant shown in Exhibits A to C," and that "the surface configuration shown in Figs. 12-15 is a faithful depiction of the surface configuration machined on the surface of the implant shown in Exhibits A to C." (October Declaration, ¶ 4.) Accordingly, even though Exhibits A to C are not cited to support a reduction to practice of the particular features noted by the Examiner, those features are included in the implant relied on to establish the reduction to practice. According to the MPEP, "[a]n accompanying exhibit need not support all

RECEIVED  
CENTRAL FAX CENTER

DEC 15 2010

Application No. 09/921,844  
Pre-Appeal Brief dated December 15, 2010  
Reply to Office Action of November 30, 2010

claimed limitations, provided that any missing limitation is supported by the declaration itself.”<sup>5</sup> In the present case, the October Declaration clearly supports the feature of claim 1 that at least a portion of the reward facet of the first surface projection overlies a portion of the forward facet of the second surface projection. (October Declaration, ¶ 5, pg. 3, lines 2-4, in combination with ¶¶ 3, 4.) Likewise, the October Declaration clearly supports the features of claim 219 that the maximum length of the forward facet is greater than the maximum length of the base, and that the “first included angle is greater than the second included angle.” (October Declaration, ¶ 5, pg. 4, lines 3-6 and 13, 14, in combination with ¶¶ 3, 4.) Thus, these features are supported by the October Declaration in accordance with MPEP § 715.07.


### III. Conclusion

In view of the foregoing remarks, it is respectfully submitted that the claims are patentable. Therefore, it is requested that the Members of the Pre-Appeal Brief Conference reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,  
MARTIN & FERRARO, LLP

Dated: December 15, 2010  
1557 Lake O’Pines Street, NE  
Hartville, Ohio 44632  
Telephone: (310) 286-9800  
Facsimile: (310) 286-2795

By:   
Amedeo E. Ferraro  
Registration No. 37,129

<sup>5</sup> MPEP § 715.07, pg. 700-283, col. 2, ¶ 4 (Rev. 6, Sept. 2007), citing *Ex parte Ovshinsky*, 10 USPQ.2d 1075 (Bd. Pat. App. & Inter. 1989).